

usable. In the instant case, invention II has separate utility such as a method for choosing a route by a client. See MPEP § 806.05(d).

In the above analysis, however, the Examiner has mischaracterized the proper standard for determining distinctness of inventions. In particular, the Examiner's assertion that "subcombinations are distinct from each other if they are shown to be separately usable" is not correct. Rather, MPEP § 806.05(d) recites that (emphasis added):

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

Under MPEP § 806.05(d), "one-way distinctness is required" for the Examiner's Restriction Requirement. To demonstrate one-way distinctness (MPEP § 806.05(d); emphasis added):

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

The Examiner has failed to identify the "single combination" in which the inventions of Groups I and II are disclosed as being usable together. The only "combination" disclosed in the application that appears to apply is the distributed computer system 10 shown in FIG. 1. In his incomplete analysis, the Examiner has only shown an example in which the asserted subcombination II is "separately usable" from the asserted subcombination I. The Examiner, however, has failed to show that one of the asserted subcombinations has utility other than in the disclosed combination, as required under MPEP § 806.05(d). To this end, the Examiner must show that one of the asserted subcombinations has utility other than in a distributed computer system.

For at least these reasons, the Examiner's asserted reasons for requiring restriction between claim Group I and claim Group II do not support the Restriction Requirement and, therefore, the Restriction Requirement should be withdrawn.

II. IT WOULD NOT BE A SERIOUS BURDEN FOR THE EXAMINER TO EXAMINE THE ENTIRE APPLICATION ON THE MERITS

MPEP § 803.01 provides that (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The Examiner has asserted that (emphasis added):

These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose. For example, the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as follows:

(a) The Group I search (claims 1-6, 12-14, 19, and 20) would require use of search Class 709, subclass 238 (not required for the invention II).

(b) The Group II search (claims 7-11 and 15-18) would require use of search Class 709, subclass 241 (not required for the invention I).

The Examiner's assertions, however, are not persuasive because the searches required for claim Groups I and II are co-extensive. In particular, Class 709, subclass 238 is defined as follows:

238 Computer-to-computer data routing:

This subclass is indented under the class definition. Subject matter further comprising means or steps for selecting a path via which the computers will transfer data.

Class 709, subclass 241 is defined as follows (emphasis added):

241 Least weight routing:

This subclass is indented under subclass 238. Subject matter further comprising means or steps for selecting the path between source and destination by which the data are transferred by optimizing at least one predetermined criteria (e.g., cost, connect time, path length/delay, preferred routing/carriers, bandwidth utilization).

Therefore, by definition, any search of Class 709, subclass 241 would be encompassed by a search of Class 709, subclass 238. That is, contrary to the Examiner's

assertion, a search of class 709, subclass 238 would be required in a search for the invention of claim Group II in class 709, subclass 241.

Furthermore, the Examiner's classification of claim Group II into Class 709, subclass 241 is improper because the invention of claim Group II is broader than least weight routing path optimization. Indeed, independent claims 7 and 15 both broadly relate to the selection at a client site of one of two or more network routes over which a logical file block of the data file is accessible based upon routing meta data incorporated within a data structure containing file access meta data including physical address meta data. Moreover, none of the claims in Group II explicitly recites a step of selecting a data routing path by "optimizing" a predetermined criterion.

For these reasons, both claim Groups I and II should be classified under the same classification (i.e., class 709, subclass 238), in which case only a single search would be required to examine both claim Groups I and II. Therefore, it would not be a serious burden for the Examiner to search and examine all of the claims in the application on the merits, regardless of whether the application includes claims that are independent and distinct.

### III. CONCLUSION

For at least the reasons explained above, Applicants request that the Examiner reconsider and set aside the Restriction Requirement dated December 10, 2004.


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